



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/550,163	04/14/2000	Igor Splawski	2323-150	8826

6449 7590 07/17/2003

ROTHWELL, FIGG, ERNST & MANBECK, P.C.
1425 K STREET, N.W.
SUITE 800
WASHINGTON, DC 20005

EXAMINER

WHITEMAN, BRIAN A

ART UNIT

PAPER NUMBER

1635

DATE MAILED: 07/17/2003

26

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/550,163

Applicant(s)

ABBOTT ET AL.

Examiner

Brian Whiteman

Art Unit

1635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5-7,9,25-30 and 69-82 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,25-30,69,70,71,74,75, and 76 is/are allowed.
- 6) ☒ Claim(s) 5-7,9,72,73 and 77-82 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Non-Final Rejection

Claims 1, 5-7, 9, 25-30, 69-82 are pending.

Applicants' traversal, the amendment to claims 7, 25, 27, 70, 71, and 75, the addition of claims 77-82 in paper no. 25 filed on 5/9/03 is acknowledged and considered.

Claim Objections

Applicant's arguments, see paper no. 25, filed 5/9/03, with respect to objection have been fully considered and are persuasive. The objection of claims 9 and 75 has been withdrawn.

Claim 79 is objected to because of the following informalities: the phrase is "a polypeptide of SEQ ID NO: 2" is grammatically improper. There is only polypeptide sequence in SEQ ID NO: 2. Suggest amending the phrase to recite -- the polypeptide of SEQ ID NO: 2 --. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claim 72 remains and claims 73, 81, and 82 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 72, 73, 81, and 82 recite the limitations "the DNA of claim 70" or "said DNA". There is insufficient antecedent basis for this limitation in the claims.

Applicant's arguments filed on 5/9/03 have been fully considered but they are not persuasive because the limitation lacks antecedent basis.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 5, 6, 7, 9, 72, and 73 remain and claims 77, 80, and 81 are rejected under 35 U.S.C. 102(b) as being anticipated by Brennan (US Patent No. 5,475,796). Brennan teaches a collection of non-identical nucleic acids capable of detecting polymorphisms. Specifically, Brennan teaches an array, which has every possible 10-mer attached to it (Example 3). One of these oligonucleotides would anticipate the probe or primer recited in the instantly rejected claims (Example 4, columns 9 and 10). Claims 5, 6, 7, 9, 72, 73, 77, 80, and 81 do not contain any structural limitation that defines the claimed probe or primer, except they hybridize to a nucleic acid encoding MiRP1 polypeptide set forth in SEQ ID NO: 2 or to a nucleic acid at a polymorphic site comprising SEQ ID NO: 2, wherein the polymorphic site is selected from the group consisting of nucleotide numbers 95, 98, 234, and 243. The nucleic acids taught by Brennan comprise at least a subset of non-identical nucleic acids would be capable of doing so by hybridization.

Applicant's arguments filed on 5/9/03 have been fully considered but they are not persuasive. The argument is not found persuasive because Brennan teaches an array with every

Art Unit: 1635

possible 10-mer. Thus, the teaching of Brennan is not a generic description of the 10-mers set forth in the claims.

Claims 5, 6, 7, 9, 72, 77, 78, 79, 80, 81 are rejected under 35 U.S.C. 102(b) as being anticipated by Kageyasu et al. (Nippon Sanshigaku Zasshi, Vol. 66, pages 477-483, 1997). Kageyasu teaches an oligonucleotide sequence, which is 25 bases long. Nucleotides 11-23 of the sequence are 100% identical to nucleotides 239-248 of applicants' SEQ ID NO: 1 or nucleotides 239-248 of a nucleotide sequence encoding SEQ ID NO: 2 (page 479, right side, 4th column, CPP-3).

Applicants' arguments with respect to claims 5, 6, 7, 9, 72, 77, 78, 79, 80, 81 have been considered but are moot in view of the new ground(s) of rejection.

Claims 5, 6, 7, 9, 72, 77, 78, 79, 80, and 81 are rejected under 35 U.S.C. 102(a) as being anticipated by Pushnova et al. (Analytical Chemistry, Vol. 260, pages 24-29, 1998). Pushnova teaches an oligonucleotide sequence, which is 25 bases long. Nucleotides 12-25 of the sequence are 100% identical to nucleotides 238-252 of applicants' SEQ ID NO: 1 or nucleotides 238-252 of a nucleotide sequence encoding SEQ ID NO: 2 (page 25, right side, 197M).

Applicants' arguments with respect to claims 5, 6, 7, 9, 72, 77, 78, 79, 80, 81 have been considered but are moot in view of the new ground(s) of rejection.

Art Unit: 1635

Conclusion

Claims 1, 25-30, 69, 70, 71, 74, 75, and 76 are free of the prior art and are in condition for allowance.

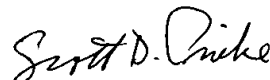
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Whiteman whose telephone number is (703) 305-0775. The examiner can normally be reached on Monday through Friday from 7:00 to 4:00 (Eastern Standard Time), with alternating Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John L. LeGuyader, SPE - Art Unit 1635, can be reached at (703) 308-0447.

Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center number is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Brian Whiteman
Patent Examiner, Group 1635


SCOTT D. PRIEBE, PH.D
PRIMARY EXAMINER